

REMARKS

Reconsideration of the present application is requested. Claims 1, 8, 12, 13, 19, 29 and 40 have been amended. Claims 1, 12 and 13 are independent claims. Example support for amendments made herein may be found in paragraphs [0003-0004] and/or [0007] of the specification.

I. CLAIM OBJECTIONS

Applicants have amended claims 8, 12, 19, 29 and 40 taking into account the Examiner's suggestions and comments made on pages 2 and 3 of the Office Action. Withdrawal of this rejection is requested.

II. STATUTORY SUBJECT MATTER REJECTION

The Examiner rejects claim 13 as allegedly being directed to non-statutory subject matter under 35 U.S.C. §101. In particular, the Examiner alleges that the computer program product of claim 13 encompasses a simple listing of source code, which is non-statutory. Applicants traverse this rejection.

A. THE REJECTION OF CLAIM 13 SHOULD BE WITHDRAWN BECAUSE THE CLAIM IS DIRECTED TO STATUTORY SUBJECT MATTER UNDER 35 U.S.C. § 101.

Claim 13 is directed to statutory subject matter under 35 U.S.C. § 101 because the claim is directed to "a computer program product." A claimed computer readable medium encoded with a computer program is statutory

subject matter.¹ Claim 13 recites, "a computer program product, adapted to cause a processor unit to simulate a technical system." In one example embodiment of the present invention, the "computer program product," of claim 13 may be a computer readable medium (e.g., a CD-ROM, a disk or any other storage medium). Therefore, the computer program product of claim 13 is statutory subject matter under 35 U.S.C. § 101 because claim 13 is not merely directed to a data structure or program listing, but instead is directed to a computer program product encoded with at least a "first program segment," "a second program segment," and a "third program segment." Withdrawal of this rejection is requested because claim 13 is directed to statutory subject matter under 35 U.S.C. § 101.

III. PRIOR ART REJECTION

The Examiner rejects claims 1-3, 5-7, 9-13, 16-18, 20-24, 26-28, 30-35, 37-39 and 41-43 under 35 U.S.C. §103(a) as being unpatentable over "Microsim Pspice A/D in Basics+", June 1997 ("Microsim") in view of U.S. Patent No. 6,327,557 ("Croix"). Applicants traverse this rejection.

A. THE ABOVE REJECTION SHOULD BE WITHDRAWN BECAUSE THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS FOR REJECTING CLAIMS 1, 12 AND 13.

The above rejection should be withdrawn because the Examiner has failed to establish a *prima facie* case of obviousness for rejecting claims 1, 12 and 13. To establish a *prima facie* case of obviousness, the Examiner must

¹ M.P.E.P. §2106 IV B1a

meet three criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify a reference or combined reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references when combined must teach or suggest all features of the claim.² Failure to meet any or all of the above criteria results in failure to establish a *prima facie* case of obviousness and the rejection should be withdrawn.

1. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE OF OBVIOUSNESS FOR REJECTING CLAIM 1 BECAUSE THE COMBINATION OF MICROSIM AND CROIX FAIL TO TEACH ALL FEATURES SET FORTH IN CLAIMS 1, 12 OR 13.

The Examiner has failed to establish a *prima facie* case of obviousness because Microsim and Croix, taken singly or in combination, fail to teach or suggest the "**setting constants**," of claim 1, for example. The Examiner relies upon "c1val," "c2val," "r1val," and "r2val," shown on page 4-4 of Microsim to allegedly teach the "setting constants," of claim 1. However, these variables fall under "PARAMS," which denotes parameters. Therefore, "c1val," "c2val," "r1val," and "r2val," of Microsim are at most arguably parameters, but not the "setting constants," of claim 1.³ In fact, Microsim fails to make any mention or suggestion of any "setting constants," of claim 1.

On page 7 of the Office Action, the Examiner correctly recognizes that Pspice fails to teach or suggest "**determining a result in the form of an**

² See M.P.E.P. § 706.02(j)

³ See, Microsim, pp. 4-3 and 4-4.

influence of the parameters on the technical system, as a function of parameters and on the basis of a request to an external source," as set forth in claim 1. The Examiner relies upon Croix to allegedly teach these features.

Croix is directed to a method and system for creating electronic circuitry. FIG.7 is a graph showing a response time r as a function of capacitive load (C_l) at an output node 612 of characterized cell 604 and time (t_r). While this graph may have been obtained by executing a "SPICE" program, contrary to the "result," of claim 1, the graph is not generated on the "basis of a request to an external source." In fact, Croix makes no mention or suggestion of any request to an external source. Croix also fails to disclose the "setting constants," of claim 1. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for rejecting claim 1 because Microsim and Croix, taken singly or in combination, fail to teach or suggest the "setting constants," of claim 1.

Moreover, both Microsim and Croix are silent with regard to parameters "optimized for a required function, the required function depending on the parameters for configuration or reaction of the technical system and setting constants that are static during optimization," as set forth in claim 1. Because this feature is not taught or suggested in Microsim or Croix, a *prima facie* case of obviousness for the above rejection has not been established.

2. A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED BECAUSE THE EXAMINER HAS FAILED TO PROVIDE THE

**NECESSARY SUGGESTION OR MOTIVATION FOR COMBINING MICROSIM
AND CROIX.**

Furthermore, the Examiner has failed to establish a *prima facie* case of obviousness for rejecting claim 1 because the Examiner has failed to provide the necessary suggestion or motivation to combine Microsim and Croix. As motivation for combining Microsim and Croix, the Examiner alleges that "cells of the circuitry are characterized with both higher speed and higher accuracy relative to previous techniques."⁴ The Examiner cites column 2, lines 10-16 of Croix in support of this statement. This argument by the Examiner is a classic "could have," combined argument: the standard, however, is "would have." The cited portion of Croix states the technical advantages allegedly provided by the teachings of Croix. This portion of Croix does not, however, establish **why the skilled artisan would have been motivated to combine the teachings of Microsim with Croix.** In particular, the Examiner has not specified what benefits incorporating the teachings of Croix into the system of Microsim would provide.

Microsim discloses a software program for circuit simulation, but fails to teach or suggest any cells of circuitry, which could be construed as similar those disclosed in Croix. The only connection between Microsim and Croix is that the system of Croix utilizes a simulation program "SPICE" similar to the one disclosed in Microsim. Therefore, the explicit advantages set forth in Croix would provide no additional advantage or benefit when incorporated into the

⁴ Office Action, pp. 8.

system of Microsim, and would not have motivated the skilled artisan to combine Microsim and Croix to arrive at the claimed invention as claimed in claim 1. Therefore, the rejection claim 1 should be withdrawn because the Examiner has failed to provide the necessary motivation for combining Microsim and Croix. Withdrawal of this rejection is requested.

The Examiner should also withdraw the above rejection of claims 12 and 13 for at least reasons somewhat similar to those discussed above with regard to claim 1. The Examiner should withdraw the above rejection of claims 2-3, 5-7, 9-11, 16-18, 20-24, 26-28, 30-35, 37-39 and 41-43 at least by virtue of their dependency from claims 1, 12 or 13.

IV. FURTHER PRIOR ART REJECTIONS

The Examiner further rejects claims 4, 14-15, 25 and 36 under 35 U.S.C. §103(a) as being unpatentable over Microsim, Croix and "common knowledge in the art."⁵ Applicants submit that the above rejection should be withdrawn for at least the reasons discussed above with regard to claims 1, 12 or 13.

Furthermore, **Applicants respectfully challenge the Examiner's taking of Official Notice** with regard to claims 4, 14-15, 25 and/or 36. The Examiner must provide some evidence in support of the Examiner's Official Notice or withdraw the above rejection.

The Examiner further rejects claims 8, 19, 29 and 40 under 35 U.S.C. §103(a) as being unpatentable over Microsim, Croix and U.S. Patent No. 6,606,612 ("Rai"). This rejection is respectfully traversed in that even

⁵ Office Action, pp. 19.

assuming *arguendo* that Microsim, Croix and/or Rai could be combined (which Applicants do not admit); Rai suffers from the same deficiencies as Microsim and Croix with regard to claims 1, 12 and 13. Therefore, the above rejection of claims 8, 19, 29 and 40 should be withdrawn because a *prima facie* case of obviousness has not been established.

V. CONCLUSION

In view of above remarks, reconsideration of the outstanding rejection and allowance of the pending claims is respectfully requested.

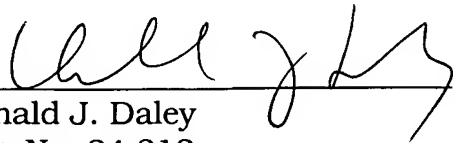
If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Andrew M. Waxman, Reg. No. 56,007, at the number of the undersigned listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully Submitted,

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